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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,330	06/26/2003	Armand Malnoe	112701-365	4205

29157 7590 01/12/2006
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EXAMINER

MCCORMICK EWOLDT, SUSAN BETH

ART UNIT	PAPER NUMBER
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1655

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/607,330

Applicant(s)

MALNOE ET AL.

Examiner

S. B. McCormick-Ewoldt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-4, 6, 8, 10-11, 14, 16, 18, 23-64 is/are pending in the application.
- 4a) Of the above claim(s) 23-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6, 8, 10, 11, 14, 16, 18, 63 and 64 is/are rejected.
- 7) ☒ Claim(s) 8 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

The amendment of November 9, 2005 is hereby acknowledged and entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant elected Group I and chicory in the Restriction Requirement dated February 8, 2005.

Claims Pending

Applicant has cancelled claims 2, 5, 7, 9, 12-13, 15, 17, 19-22. Claims 23-62 have been withdrawn from consideration. Applicant has added claims 63-64. Claims 1, 3-4, 6, 8, 10-11, 14, 16, ^{and 63-64} and 18 will be examined.

Claim Objections

Claims 8 and 16 are objected to because of the following informalities: the word "claims" should be --claim--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1, 3-4, 6, 8, 10 and 63-64 are rejected under 35 U.S.C. 112, first paragraph, as stated previously in the Office action, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant's arguments filed September 6, 2005 have been fully considered but they are not persuasive.

Applicant's claims are broadly drawn to prevent inflammation in a mammal. The specification is not considered to enable this use. Applicant's specification does not give any examples that show that chicory is able to prevent inflammation. "Prevention" of inflammation requires prevention of each and every instances of inflammation. Such prevention is difficult, if not impossible, to achieve. Thus, Applicant does not provide enough information for a person of ordinary skill in the art to determine without undue experimentation that the chicory claimed is able to prevent inflammation.

Applicant argues the examples disclosed in the specification sufficiently establish that chicory is capable of preventing inflammation. This is not persuasive as the Applicant maintains the word “prevent” in the claims. Applicant’s claims are broadly drawn to preventing inflammation in a mammal. Applicant has reasonably demonstrated that chicory inhibits inflammation as shown in Table 1 of the specification. However, the present claims recite, “prevent,” and prevention is deemed to be a “cure” since prevention of a disease is interpreted to mean that the disease will entirely cease to manifest after administration of the composition. Applicant has not demonstrated treatment of preventing inflammation in a mammal, in order to provide some reasonable nexus between chicory and preventing the disclosed ailment as described above.

Thus, Applicant does not provide enough information for a person of ordinary skill in the art to determine without undue experimentation that chicory extract as claimed is able to prevent inflammation in a mammal.

Therefore, the rejection is deemed proper and is maintained.

Claim Rejections - 35 USC § 102

Claims 1, 3-4, 6, 8, 10-12, 14, 16, 18 and 63-64 are rejected under 35 U.S.C. 102(e) as being anticipated by Hermand (US 6,645,534 B2).

Hermand (US 6,645,534 B2) teaches chicory is capable of pharmacological properties such as anti-inflammatory efficacies. In addition, Hermand teaches extracting chicory by hot extraction method and has at least 5% chicory content (column 1, lines 21-27; column 2, lines 1-7, 38-41). The hot extraction of chicory used as anti-inflammatories by Hermand meet the limitations of claim 1 as the composition comprises extracts of chicory and thus anticipates the claimed invention. Applicant’s arguments filed September 6, 2005 have been fully considered but they are not persuasive.

Applicant argues that Hermand fails to disclose a composition for preventing inflammation in a mammal, which contains plant material in an amount from at least 0.5% to less than 5% by weight of composition. This is not found persuasive because Hermand discloses the chicory concentration of the extract is about 4.5% by weight (see column 6, lines 19-21). With regards to Hermand failing to disclose a composition for preventing inflammation in a mammal,

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Applicant is requested to note that it is regarded that “intended use” of a composition or product (e.g. inflammation) will not further limit claims drawn to a composition or product. See, e.g., *Ex Parte Masham*, 2 USPQ2d 1647 (1987) and *In Re Hack* 114, USPQ 161. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Therefore, the rejection is deemed proper and is maintained.

Claim Rejections - 35 USC § 103

Claims 1 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hermand (US 6,645,534 B2) as previously stated in the prior Office action.

Hermand (US 6,645,534 B2) discloses that chicory is capable of pharmacological properties such as anti-inflammatory efficacies. In addition, Hermand teaches extracting chicory by hot extraction method and has at least 5% chicory content (column 1, lines 21-27; column 2, lines 1-7, 38-41). Applicant’s arguments filed September 6, 2005 have been fully considered but they are not persuasive.

Applicant argues that Hermand fails to disclose a composition for preventing inflammation in a mammal, which contains plant material in an amount from at least 0.5% to less than 5% by weight of composition and teaches away from the range by disclosing higher levels are required to attain optimal pharmacological and physical properties. This is not found persuasive because Hermand discloses the chicory concentration of the extract is about 4.5% by weight (see column 6, lines 19-21). With regards to Hermand failing to disclose a composition for preventing inflammation in a mammal, Applicant is requested to note that it is regarded that “intended use” of a composition or product (e.g. inflammation) will not further limit claims drawn to a composition or product. See, e.g., *Ex Parte Masham*, 2 USPQ2d 1647 (1987) and *In Re Hack* 114, USPQ 161. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably

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distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Therefore, the rejection is deemed proper and is maintained.

Summary

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

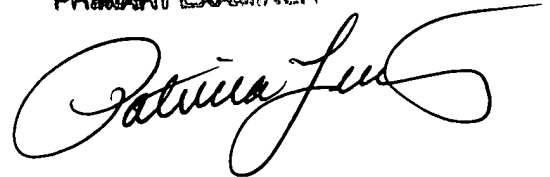
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Terry McKelvey, can be reached on (571) 272-0775. The official fax number for the group is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sbme

PATRICIA LEITH
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Patricia Leith', written in a cursive style.